



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/040,825	03/18/1998	MARIO FRYBERG	ICH275	2298

25230 7590 06/07/2002

DARA L ONOFRIO
ONOFRIO LAW
1133 BROADWAY
SUITE 1600
NEW YORK, NY 10010

EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
----------	--------------

1774

26

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/040,825

Applicant(s)
Mario FRYBERG et al.

Examiner
M. Yamnitzky

Art Unit
1774



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, and 6-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, and 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1774

1. This Office action is in response to the paper headed "Amendment" which was filed on 03/08/02 (Paper No. 25). The "amendment" is treated as a request for reconsideration as no changes to the claims or specification are made by the paper.

Claims 3, 4 and 6-13 are pending.

2. As noted in Paper No. 22, the request for a CPA filed on 05/14/01 was improper and was treated as a request for continued examination under 37 CFR 1.114. In Paper No. 25, applicants argue that the application was originally filed on 03/18/98 and therefore the prior application was a utility application filed under 35 U.S.C. 111(a) before 05/29/00 and the CPA request was proper. While the application was originally filed on 03/18/98, a proper CPA request was subsequently filed on 07/14/00. The CPA request filed on 07/14/00 had the effect of giving the application a new filing date of 07/14/00 with an effective U.S. filing date of 03/18/98. Accordingly, the "prior application" for purposes of the CPA request filed on 05/14/01 was/is an application having a filing date after 05/29/00 (specifically, 07/14/00). The CPA request filed on 05/14/01 stands as an improper request for a CPA and stands treated as a request for continued examination under 37 CFR 1.114.

3. Claims 3, 4 and 6-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record in Paper No. 22.

Art Unit: 1774

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4 and 6-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kono et al. (4,801,497) or Kashiwazaki et al. (5,747,146), either of these patents taken in view of Smigo et al. (5,281,307) for the reasons of record in Paper No. 22.

6. Miscellaneous: As noted in Paper No. 22, "mixture" should read --mixture-- in "(b)" of claim 12.

7. Applicants' arguments filed 03/08/02 have been fully considered but they are not persuasive.

The examiner notes that applicants presented no arguments directed to the rejection under 35 U.S.C. 112, second paragraph.

Regarding the rejection under 35 U.S.C. 103(a), applicants argue that none of the cited art teaches or suggests the invention as defined in the claims. Applicants argue that the claims define the recording sheet layer (ink-receptive layer) as including at least one binder and at least one

Art Unit: 1774

copolymer, the copolymer being present in an amount of 10 to 75% of the combined amount of copolymer and binder which provides the sheet with enhanced light fastness properties.

It is the examiner's position, for the reasons set forth in the rejection in Paper No. 22, that a recording sheet comprising an ink-receptive layer containing at least one copolymer of the formula set forth in the claims in an amount within the range of 10 to 75 wt% based on the weight of the copolymer and binder would have been obvious to one of ordinary skill in the art at the time of the invention given the teachings of the Kono patent in view of the teachings of the Smigo patent, or given the teachings of the Kashiwazaki patent in view of the teachings of the Smigo patent. As stated in the rejection as set forth in Paper No. 22, it is the examiner's position that the recording medium of Kono or Kashiwazaki, as modified to include the copolymer disclosed by Smigo in Kono's or Kashiwazaki's ink-receptive layer, would inherently have enhanced light fastness properties absent objective evidence to the contrary. Applicants' arguments filed 03/08/02 do not convince the examiner that a recording sheet comprising an ink-receptive layer containing at least one copolymer of the formula set forth in the claims in an amount within the range of 10 to 75 wt% based on the weight of the copolymer and binder is patentable over the applied prior art, and applicants have provided no objective evidence demonstrating that the recording medium of Kono or Kashiwazaki, as modified to include the copolymer disclosed by Smigo in Kono's or Kashiwazaki's ink-receptive layer, would not inherently have enhanced light fastness properties.

Art Unit: 1774

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax numbers for Art Unit 1774 are (703) 872-9311 for official after final faxes and (703) 872-9310 or (703) 305-5408 for all other official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
06/06/02

Marie R. Yamnitzky
MARIE YAMNITZKY
PRIMARY EXAMINER
1774